D. REMARKS

Applicants respectfully request reconsideration of the outstanding rejections and reexamination of the present application in light of the following amendments and remarks.

Status of the Claims

Claims 1, 5, 6, 10, 11, and 12 are currently pending. Claims 2-4, 7-9, and 13-19 are currently canceled. Claims 1, 6, 11, and 12 are currently amended.

Information Disclosure Statement

Applicants note that Examiner did not enter the information disclosure statement filed 02/12/2004 because the information disclosure statement cover sheet included the name "Grubbs et al" in the header, although the other forms did include the inventor name "Keohane et al" and the information disclosure statement was filed with the present application. Regardless of whether this is a proper reason for not entering an information disclosure statement, Applicants resubmit the same references which were previously cited in the information disclosure statement and request entry of the information disclosure statement and consideration of the references.

Drawings

The Office Action objects to Figures 2, 5, and 7 because it states that Figures 2, 5, and 7 contain labels that have unclear subject matter. [Office Action, p. 2]

In particular, the Office Action states that "in Figure 2 it is unclear that label 200 is identifying the entire system." [Office Action, p. 2] Applicants amend Figure 2 to include a bracket identifying that label 200 identifies the entire system.

In addition, in particular, the Office Action states that "in Figure 5 label 512 is not clear that it is identifying the email, an element of the element or the highlighting of the email." [Office Action, p. 2] Applicants add a label 514 indicating the highlighting of the entry, with a bracket identifying the entry at label 512.

The Office Action does not specify an portion of Figure 7 which is unclear, however the Examiner requests that Applicants identify the label associated with "sender M" within the e-mail entry with highlighting identified by label 712. Applicants amend Figure 7 to include a bracket identifying the email entry for "sender M" with label 710 and the highlighting identified by label 712.

Specification

The Office Action objects to paragraph 0009 on the grounds that it "is confusing. As it reads now, it is unclear as to what the suggested folder would be named. Examiner assumes that the applicant intended the second sentence of paragraph [0009] to read: "the suggested folder is the folder with the same name as the detected suggested folder name." [Office Action, p. 3]

In addition, the Office Action objects to paragraph 0064 and requests that applicant include "the reference number for "sender M" in the description in paragraph 0064." [Office Action, p. 3] Applicants respectfully note that in order to clarify the labeling within Figure 7, Applicants distinguish between a label 712, which refers to the highlighting and an additional label 710, which refers to the actual e-mail message from "sender M". Applicants amend paragraph 0064 to include the reference number for "the e-mail message from "sender M"" as originally described in the specification to refer to label 710. Applicants respectfully request entry of the clarification.

Further, the Office Action objects to block 1130 of Figure 11 because Applicant allegedly does not provide adequate description for what occurs in block 1130 of Figure 11. [Office Action, p. 4] In particular, the Office Action states that "Applicant describes block 1130 as "automatically jumping through the recipient folder directory to display a target folder in the recipient folder directory." Examiner is unclear as to what automatically jumping through the recipient folder directory does, or how it enables the ability to display a target folder in the recipient folder directory." [Office Action, p. 4] Applicants note that the term "jumping" can be interpreted in view of the specification as a whole as "expanding" or "opening". Block 1130 in Figure 11 is triggered if a recipient

selects to file a message and the message does not include a suggested folder name, so a target folder name is displayed in the recipient folder directory. Paragraph 0045 of the specification describes that when a user selects to file a message, "the folder directory is preferably automatically opened to the locations of the suggested folders" and paragraph 0063 of the specification describes that when a user selects to file a message, in a multi-tiered folder structure, a folder is automatically expanded to reveal a target folder at another tier. Applicants respectfully assert that "jumping through" the directory to display a target folder in the recipient folder directory refers to expanding or opening the directory to display the target folder, and therefore there is adequate description for block 1130 within the specification.

Claim Amendments overcome Rejections

The Office Action rejects claims 1, 3, 6, 8, 11, and 13 under 35 USC 102(e) as being anticipated by Scian et al. (US Publication 2006/0026236) (herein referred to as Scian). [Office Action, p. 4] Applicants cancel claims 3, 8, and 13 and respectfully traverse the rejections of pending claims 1, 6, and 11 under 35 USC 102(e). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Scian does not teach each and every element of claims 1, 6, or 11 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed. In addition, Applicants note that claims 1, 6, and 11 are amended to incorporate elements previously taught in claims 14, 15, and 16 and rejected under 35 USC 102(b) as being anticipated by Mousseau (US Publication 2002/0120696). Applicants respectfully traverse the rejection of the claims with regard to the previously rejected portions under Mousseau and respectfully assert that Mousseau does not teach or enable each

element of the previously rejected portions or each and every element of claims 1, 6, or 11.

Claims 1, 6, and 11

Claim 1 reads:

Claim 1 (Currently Amended): A method for providing electronic message filing recommendations comprising:

detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;

attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient;

sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient;

responsive to receiving said electronic message at said recipient system for said recipient, filtering [[an]] said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message determine at least one suggested folder for filing said electronic message from among a plurality of filing folders in a messaging filing directory; and

responsive to said recipient selecting to file said electronic message, automatically expanding a display directory distinguishing said at least one suggested folder from a remainder of said plurality of filing folders to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

First, Applicants respectfully assert that the amendments to claim 1 are fully supported in the specification, therefore no new matter is added through the amendments to the claim. In particular, as to the elements of detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message and attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient, paragraphs 0015, 0040, 0043, 0046, 0054, 0056, and 0057 teach each

of the claimed limitations. In addition, as to <u>responsive to receiving said electronic</u> <u>message at a recipient system for said recipient, filtering said electronic message to</u> <u>detect said at least one suggested folder name specified by said sender in said</u> <u>electronic message</u>, paragraphs 0043, 0053, and 0059 teach each of the claimed limitations. Further, as to <u>responsive to a recipient selecting to file said electronic</u> <u>message, automatically expanding a display directory of said plurality of filing folders to</u> <u>display said at least one suggested folder in a graphically distinguishable format from</u> <u>said display of other folders of said plurality of filing folders</u>, paragraphs 0045, 0050, 0051, 0052, 0060, and 0062 teach each of the claimed limitations.

Second, Applicants respectfully assert that Scian does not anticipate claim 1 as currently amended. In particular, regardless of whether the Examiner's assertions in the Office Action are correct, clearly Scian does not teach or enable the elements of <u>detecting, at a sender system, a sender selection within a user interface of at least one</u> <u>suggested folder name for a composed electronic message for a recipient receiving the</u> <u>electronic message to select as a folder name for filing said electronic message</u> or <u>attaching said at least one suggested folder name to said electronic message at said</u> <u>sender system for distribution to said recipient</u> because Scian does not teach or enable a sender to set a suggested folder name. In addition, Scian does not teach or enable the element of <u>responsive to receiving said electronic message at a recipient system for</u> <u>said recipient, filtering said electronic message to detect said at least one suggested</u> <u>folder name specified by said sender in said electronic message for filing said electronic</u> <u>message from among a plurality of filing folders in a messaging filing directory</u> because Scian does not teach or enable filtering an electronic message to detect a suggested folder name already specified by the sender in the electronic message. Further, Scian does not teach or enable the element of <u>responsive to said recipient selecting to file</u> <u>said electronic message, automatically expanding a display directory of said plurality of</u> <u>filing folders to display said at least one suggested folder in a graphically distinguishable</u> <u>format from said display of other folders of said plurality of filing folders</u> because Scian's description of a user interface with means for displaying the pre-selected folder in

paragraph 0027 does not explicitly or implicitly teach automatically displaying a director of filing folders to display the suggested folder in a graphically distinguishable format from the other folders.

In addition, Applicants respectfully assert that claim 1 is not anticipated by Mousseau. Applicants note that the Examiner previously rejected claim 14 under 35 USC 102(e) as anticipated by Mousseau. Claim 14 included in the elements of "detecting an electronic message created by a sender", "attaching a suggested filing folder name to said electronic message", and "sending said electronic message with said suggested filing folder name, such that efficient filing of said electronic message by a recipient of said electronic message in a folder with said suggested filing folder name is facilitated." Applicants amend claim 1 to include the elements of detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message and attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient. Applicants respectfully assert that Mousseau does not teach the element of detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message because Moussea's description of a mobile system and host system transferring data to synchronize filing directories does not teach or enable a sender composing an electronic message to designate a suggested filing folder name for a recipient of the electronic message to select for filing the electronic message. In particular, paragraph 0102 of Mousseau describes sending the folder hierarchy from the host system to the mobile device and matching the hierarchies to one another, and similarly comparing messages between the host system and mobile device and synchronizing the placement of messages between the two systems. Mousseau's synchronization of folder hierarchies and messages within hierarchies between two systems does not teach a sender selecting a suggested folder name for consideration

by a recipient of an electronic message when the sender composes the electronic message. Because Mousseau does not teach or enable <u>detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message</u>, Mousseau does not anticipate claim 1 as amended.

Therefore, because claim 1 is not anticipated by the prior art under 35 USC 102(e), Applicants respectfully request withdrawal of the rejection of claim 1 and allowance.

In addition, with regard to claims 6 and 11, these claims are rejected for the same reasons as claim 1, and amended in a similar manner to claim 1, and are therefore allowable for at least the same reasons as claim 1.

<u>Claims 5, 10, and 12</u>

Claims 5 and 10 are dependent claims rejected under 35 USC 103(a) as being unpatentable over Scian in view of Gleicher. Claim 12 is amended to teach elements similar to the elements in claims 5 and 10. Regardless of whether the rejection of claims 5 and 10 is correct, claims 5, 10, and 12 are dependent claims of independent claims 1, 6, and 11. Since claims 1, 6, and 11 are not anticipated by Scian or the other prior art, dependent claims 5, 10, and 12 should be allowed as dependent claims of allowable independent claims.

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

No extension of time is believed to be necessary. If, however, an extension of time is required, the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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